

## **REMARKS**

### **I. Status of Claims**

Currently, claims 1-19 are pending in this application. The Office has noted that claims 4-19 are allowable. By this Amendment, Applicant proposes to amend claim 1 to recite “wherein said first and second vectors recombine to form a co-integrate vector comprising said double stranded origins of replication from said first vector and said second vector, and wherein said host cell further expresses a gene encoding a Rep protein that can initiate rolling circle replication at said double stranded origins of replication in said co-integrate vector, and wherein said introducing permits formation of to form a product vector comprising . . .” Support for this amendment can be found throughout the specification, including, for example, at page 14, lines 1-18. Accordingly, the amendment does not introduce new matter into the specification.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-19 in condition for allowance. Applicant submits that the proposed amendment of claim 1 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, because all of the elements and their claimed relationships were either claimed earlier or inherent in the claims as examined. More specifically, claim 2, which recites “wherein said prokaryotic host cell is grown under conditions which permit said first and second vectors to recombine to form a co-integrate vector[.]” has already been examined. Therefore, this Amendment should allow for immediate action by the Examiner. Furthermore, the proposed amendment would place the claims in better form for appeal, should an appeal be necessary.

Applicant notes that a Notice of Appeal is being filed with this Amendment After Final.

**II. Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Office rejects claims 1-3 under 35 U.S.C. §112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Office Action at 2. Specifically, the Office asserts:

As above, lines 20-21 [of claim 1] include the limitation that the host cell expresses a rep protein that can initiate rolling circle replication at said double stranded origins of replication. At this point in the method, the claim describes only the first and second vectors with double stranded origins of replication. Immediately following, the claim includes recitation of the Rep protein that acts on the double stranded origins of replication and followed by the phrase “said introducing permits formation of product vector”. Therefore, the skilled artisan is presented with a method comprising the step of introducing a first and second vector, which permits formation of a product vector. As the claim is written, it is not clear how the formation of the product vector is taking place. It is unclear whether the Applicants intend the product vector to be formed by site-specific recombination between the two vectors to form a disclosed, but not recited, cointegrate vector which is subject to further steps, or if the product vector should be formed in some other manner.

*Id.* at 5-6.

Although Applicant respectfully disagrees, in an effort to expedite prosecution, Applicant proposes that claim 1 be amended to recite “wherein said first and second vectors recombine to form a co-integrate vector comprising said double stranded origins of replication from said first vector and said second vector, and wherein said host cell further expresses a gene encoding a Rep protein that can initiate rolling circle replication at said double stranded origins of

replication in said co-integrate vector to form a product vector comprising . . . ." As amended, claim 1 more clearly sets forth how the product vector is formed. Accordingly, Applicant respectfully requests that the Office reconsider and withdraw this 35 U.S.C. §112, second paragraph, rejection.

### **III. Conclusion**

Applicant believes that all of the substantive issues raised in the Final Office Action dated 27 March 2007 have been addressed, and all objections and rejections overcome. Accordingly, Applicant believes that this application is in condition for allowance. If the Office believes anything further is required in order to place this application in even better condition for allowance, Applicant requests that its undersigned representative be contacted at the number listed below to discuss remaining issues.

Please grant any extensions of time required to enter this paper and charge any additional required fees to Deposit Account No. 50-3740.

Respectfully submitted,  
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